Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NEIL J. SHERRY

Appeal No. 1999-0939
Application No. 08/593,334

HEARD: January 27, 1999

Before STAAB, NASE, and GONZALES, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13 through 23, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a method of fastening members of an assembly, such as sheets or the like (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Parsons et al. (Parsons)	2,180,545		Nov. 21, 1939
Lelaurain	2,017,426	(UK)	Oct. 3, 1979
Bradley et al. (Bradley)	2,140,891	(UK)	Dec. 5, 1984

Claims 13 through 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bradley in view of Parsons and Lelaurain.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 13, mailed November 24, 1997) and the answer (Paper No. 19,

mailed July 14, 1998) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 18, filed April 28, 1998) and reply brief (Paper No. 20, filed September 14, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 13 through 23 under
35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claim 13, the sole independent claim on appeal, recites a method of fastening two members together, comprising the steps of (1) providing first and second members, (2) piecering the second member to form an aperture and cleavage and then deforming the aperture and cleavage into a wall having a thread-like helical form, (3) bringing the first and second members together in face to face relationship, (4) inserting a tubular fastener through the aperture in the second member and an aperture in the first member, and (5) radially expanding a shank of the tubular fastener thereby causing the wall having

a thread-like helical form to impress a helical groove into the shank.

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree. In our view, the above-noted limitations of claim 13 are not suggested by the applied prior art. In that regard, while Parsons does teach piecering a member to form an aperture and cleavage and then deforming the aperture and cleavage into a wall having a thread-like helical form, it is our opinion that the applied prior art would not have suggested replacing Bradley's second member (i.e., workpiece 56) with Parsons' threaded member and removing the threads from Bradley's fastener 10 so that radially expanding Bradley's fastener 10 causes the wall having a thread-like helical form of the second member to impress a helical groove into Bradley's fastener 10.

In our view, the only suggestion for modifying Bradley in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight

knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejection of claims 13 through 23.

CONCLUSION

To summarize, the decision of the examiner to reject claims 13 through 23 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB Administrative Patent Judge	)	
JEFFREY V. NASE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN F. GONZALES Administrative Patent Judge	)	

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APPLICATION NO. 08/593,334

APJ NASE

APJ STAAB

APJ GONZALES

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 02 Feb 00

FINAL TYPED:

HEARD: January 27, 1999